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Application Number: 10/673,827
Applicant: Roth, Mathew R.
Filed: 9/29/2003
For: Apparatus and Method to
Manufacture a Leaf Display Device

Examiner: Agrawal, C.
Art Unit: 3726
Date: 12/6/2005
Docket: 0342UR

APPLICANT'S RESPONSE TO THE RESTRICTION REQUIREMENT

The following remarks are addressed to the restriction requirement mailed 10/27/2005 for the subject patent application:

I. PROVISIONAL ELECTION WITH TRAVERSE.

Applicant acknowledges the Examiner's opinion that distinct species are claimed in claims 1 – 10 and 19 – 30 (Species I: method of manufacturing a leaf display device) and claims 11 - 18 (Species II: apparatus for manufacturing a leaf display device).

Applicant provisionally elects with traverse Species I: method of manufacturing a leaf display device as claimed in claims 1 – 10 and 19 – 30. In addition, Applicant provisionally elects with traverse Species B (claims 26 – 28) and Species 1 (Claim 29).

II. TRAVERSAL.

The statutory basis for restriction requirements is 35 USC § 121, whose first sentence reads "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." The remainder of section 121 enumerates the applicant's rights: (second sentence) any divisional application which complies with 35 USC § 120 will receive the benefit of the earlier filing date of the original application, (third sentence) divisionals filed prior to the issuance of the original

1 application shall not be used as a reference against the original and visa-versa, (fourth sentence)
2 signing and executing the divisional application may not be required by the inventor if the
3 divisional is directed solely to subject matter contained in the original application, and (fifth
4 sentence) the validity of a patent shall not be questioned for failure of the Commissioner to
5 impose a restriction requirement.

6
7 The Patent & Trademark Office's interpretation of the first sentence of 35 USC § 121 is
8 colorfully summarized in Patent Practice:

9
10 The statutory prerequisite for restriction in 35 USC § 121 is "two
11 or more independent and distinct inventions ... claimed in one
12 application." It is fair to say that the PTO gives absolutely no
13 weight to the conjunctive "and" in that phrase, as the word is
14 normally understood; and, in an interesting tour de force of
15 statutory construction, rewords the statute to mean "independent or
16 distinct."¹

17
18 This PTO transformation of "and" into "or" was challenged in 1978.² The Commissioner
19 declined to change the interpretation practice, and so current practice remains that either
20 "independent" or "distinct" inventions contained in a common application will suffice to trigger a
21 restriction requirement. Therefore, each of these criteria must be examined in turn.

¹ Irving Kayton, Patent Practice note 2 at 14-33 .

² See In Re Lee, 199 USPQ 108 (Com. Pat. 1978) (applicant's
petition to the Commissioner to withdraw the Examiner's
restriction requirement granted; applicant's petition to the
Commissioner that "independent *and* distinct" in 35 USC § 121 be
interpreted henceforth as "independent *and* distinct", and not
"independent *or* distinct" was denied).

1 **A. RESTRICTION IS NOT PROPER BECAUSE SPECIES I AND SPECIES II ARE**
2 **NOT INDEPENDENT INVENTIONS**

3
4 The Patent & Trademark Office defines independent inventions as inventions between which no
5 relationship is disclosed, that is, they are not connected in design, operation or effect.³ Examples
6 of independent inventions given include: 1. different combinations not disclosed as being usable
7 together and having different modes of operation, function or effects, 2. process and apparatus
8 wherein the apparatus cannot be used to practice any part of the process, and 3. independent
9 species under a genus.⁴

10
11 In the instant case, the Restriction Requirement does not assert that species A and B are 1.
12 different combinations not disclosed as being usable together and having different modes of
13 operation, function or effects, 2. process and apparatus wherein the apparatus cannot be used to
14 practice any part of the process, nor 3. independent species under a genus. To the contrary, the
15 instant Species I and II are related as process and apparatus for its process, and are therefore
16 related and not independent.

17
18 **B. RESTRICTION IS NOT PROPER BECAUSE SPECIES I. AND SPECIES II. ARE**
19 **NOT DISTINCT INVENTIONS.**

20
21 A process and apparatus for its practice may be shown to be distinct if at least one of the
22 following is shown to be true: 1. the process as claimed can be practiced by another materially
23 different apparatus or by hand, or 2. the apparatus as claimed can be used to practice another and
24 materially different process. M.P.E.P. § 806.05(e). The Examiner carries the burden of
25 providing an example which need not be documented. If the applicant makes a convincing

³ PATENT & TRADEMARK OFFICE, U.S. DEPT OF COMMERCE, MANUAL
OF PATENT EXAMINING PROCEDURE § 802.01 (1998).

⁴ *Id.* at § 806.04.

1 argument that the example provided by the Examiner would not be workable, then the burden is
2 on the Examiner to provide another viable example or to terminate the restriction requirement.

3 *Id.*

4
5 In the instant case the Examiner does not propose that the claimed process for using the product
6 can be practiced with a materially different product. Rather, the suggestion is made in the
7 election requirement mailed 10/27/2005 that the method of manufacture can be practiced by
8 using adhesive paper, sheets of transparent plastic, or by hand.

9
10 The instant method comprises the steps of cutting a stem 2, stacking its leaves, and holding the
11 leaves in a broadleaf stem holder 30 within a notch 32 or recess 50 pending assembly into a leaf
12 display device such as a wreath or garland. See Application pg. 3 line 3 and e.g. claims 8 – 10,
13 23 – 25, or 26 – 28. Broadleaf stem holder 30 must be capable of holding a stacked stem in the
14 correct configuration until assembly. See Application pg. 5 lines 10, 11.

15
16 Thus, broadleaf stem holder 30 must be sufficiently strong and rigid so as to hold stacked stems
17 in the correct configuration against their natural springiness, and the tendency of rotated leaves to
18 un-rotate. For example, broadleaf stem holder 30 may incorporate outer reinforcements 38 (see
19 figures 12 – 14) to lend rigidity and strength sufficient to hold stacked stems in the correct
20 configuration against their natural springiness, and the tendency of rotated leaves to un-rotate.
21 See Application pg. 13 lines 9 – 12.

22
23 Another important function of broadleaf stem holder 30 is the ability to store stacked stems
24 pending assembly, and to easily transport stacked stems to assembly stations, in order to increase
25 production efficiency. See Application pg. 4 lines 10 – 12, pg. 13 lines 2 – 5, and pg. 14 lines 4
26 – 10 and 12 - 14.

1 The election requirement mailed 10/27/2005 asserts that the important functions (described
2 above) of: 1. holding stacked stems in the correct configuration against their natural resiliency,
3 2. doing so for substantial periods of time pending their assembly into leaf display devices, and 3.
4 holding the stacked stems in the correct configuration while the stacked stems are being
5 transported from stacking station to storage station and thence to assembly station, can be
6 practiced by using adhesive paper, sheets of transparent plastic, or by hand.

7
8 As explained above, broadleaf stem holder 30 must be sufficiently strong and rigid to hold
9 stacked stems in the correct configuration against their natural springiness, and the tendency of
10 rotated leaves to un-rotate. Adhesive paper is flexible verging on flimsy, and would not exhibit
11 sufficient rigidity to accomplish the task.

12
13 Notch 32 or recess 50 in broadleaf stem holder 30 must be of correct width to hold stacked stems
14 in the correct configuration against their natural resiliency. See Application pg. 13 lines 14 – 19
15 and pg. 14 line 21 – pg. 15 line 2. Thus, apparatus structure is required to maintain the correct
16 size of notch 32 or recess 50. Merely placing a sheet of material, transparent plastic or otherwise,
17 over stacked stems would not work: even if the sheets were of sufficient weight to maintain the
18 stacked stems in the correct stacked configuration, removal of the sheet would allow them to
19 unravel. In addition, stacked stems already under a sheet would tend to unravel when the sheet is
20 lifted in order to place additional stacked stems under the sheet. For these reasons, sheets would
21 not work in the present application.

22
23 Finally, the election requirement mailed 10/27/2005 asserts that the broadleaf stem holder 30
24 functions of: 1. holding stacked stems in the correct configuration against their natural
25 resiliency, 2. doing so for substantial periods of time pending their assembly into leaf display
26 devices, and 3. holding the stacked stems in the correct configuration while the stacked stems are
27 being transported from stacking station to storage station and thence to assembly station, could

1 be accomplished by hand. A stated objective of the instant invention is to increase production
2 efficiency. See Application pg. 14 lines 12 – 14. Using human labor to accomplish these
3 functions would tie up dozens of laborers to hold, store, and transport only a few hundred stacked
4 stems! Accomplishing these tasks by hand would decrease production efficiency, not increase it.
5 For these reasons, hand labor would not work in the present application.

6
7 Because use of adhesive paper, sheets of transparent paper, or hand labor would not work in the
8 instant application, species I and II are distinct, and therefore restriction is improper. Applicant
9 respectfully requests reconsideration and withdrawal of the restriction requirement.

10
11 **C. THE RESTRICTION REQUIREMENT FAILS TO PROVIDE THE REQUIRED**
12 **REASONS FOR INSISTING ON RESTRICTION, AND THEREFORE SHOULD BE**
13 **WITHDRAWN.**

14
15 In general, all restriction requirements must have two parts: 1. the reasons the Examiner has for
16 concluding that a plurality of inventions are either independent or distinct, and 2. the Examiner's
17 reasons for insisting on the restriction requirement.⁵ This may be accomplished by showing the
18 inventions are classified in different classifications, that they have a separate status in the art
19 where the different inventions are classified together, or that differing fields of search would be
20 required if the inventions were to be examined under a single application.⁶ Mere conclusions are
21 insufficient, but rather the existence of any of the foregoing reasons must be established by
22 appropriate explanation.⁷

23

⁵ *Id.* at § 808.

⁶ M.P.E.P. 808.02.

⁷ M.P.E.P. 808.02.

1 A showing that a significant added burden on the Examiner is a required element in the *prima*
2 *facie* case for restriction made in any legally sufficient Restriction Requirement. Because this
3 necessary element is absent from the Restriction Requirement mailed 10/27/2005 a *prima facie*
4 case for restriction has not been made, and the Restriction Requirement should be withdrawn.

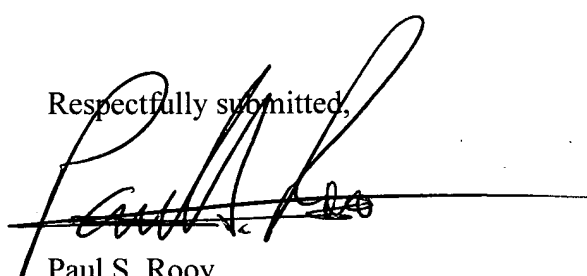
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6 **IV. LATE FEE.**

7
8 A check for \$60.00 to "Commissioner for Patents" is herewith enclosed for response within the
9 first month after the due date.

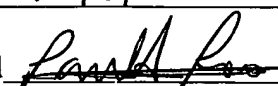
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11 **IV. CONCLUSION.**

12
13 Restriction is not proper because Species I and Species II are neither independent inventions nor
14 distinct inventions. In addition, the Restriction Requirement mailed 10/27/2005 fails to explain
15 the reasons for insisting on restriction. Therefore, Applicant requests reconsideration and
16 withdrawal of the election requirement.

17
18 Respectfully submitted,

19
20 
21 Paul S. Rooy
22 Reg. No. 35,338

23
24 I hereby certify this correspondence is being deposited with the United States Postal Service as
25 first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450,
26 Alexandria VA 22313-1450 on 12/6/2005.

27
28 Signed 
29 Reg. No. 35,338

30
31 Date 12/6/2005.